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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/386,605	08/31/1999	CHRISTOPHER G. TAYLOR	38-21-(15757	1594

27161 7590 12/03/2002

MONSANTO COMPANY
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EXAMINER

HELMER, GEORGIA L

ART UNIT

PAPER NUMBER

1638

DATE MAILED: 12/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/386,605	TAYLOR ET AL.
	Examiner	Art Unit
	Georgia L. Helmer	1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 11 June 2002.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 12-26 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-11 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) Paper No(s). <u>15</u> .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.	6) <input type="checkbox"/> Other: _____

OFFICE ACTION

1. This is a supplemental action, vacating the Office action of August 27, 2002.

This action is a Final action. The action August 27, 2002 is a Final action. However, an inadvertent error was made in the Office Action Summary (PTO-326) of the August 27, 2002 action—the Status of the action was checked as being non-final. This is incorrect. The instant action corrects this mistake. The August 27, 2002 Rejection raised no new grounds of rejection and is a proper final rejection.

Applicant Tom McBride queried the Examiner on November 25, 2002 about this discrepancy, bringing it to the Examiner's attention. The Office regrets any inconvenience caused to Applicant.

Status of the Claims

2. The Office acknowledges receipt of Applicants Response; dated 11 June 2002, paper number 12.
3. Applicant has amended claims 1, 3, 8 and 11. Claims 1-28 are pending. Claims 1-11 are examined in the instant action.

This action is made FINAL.

4. All rejections not addressed below have been withdrawn.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-11 rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for soybean hypocotyls and potato branches, does not reasonably provide enablement for any explant of any plant. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Applicant's claims are broadly drawn to any explant of any plant.

Re any explant:

Applicant teaches soybean hypocotyls and potato branches. Hypocotyls and stems are not representative of all explants. Stems and hypocotyls are explants which have undergone differentiation and possess special features such as hormone gradients (Raven et al, Biology of Plants (1992), Worth Publishers, New York, NY 10003, pages 548). These explants (stem & hypocotyls) "know which end is up". Not all explants have these features. It is unpredictable that other explants not having these features, would be capable of functioning in the same way as stems and hypocotyls in the claimed invention. Neither the prior art nor Applicant's disclosure shows that explants other than stems and hypocotyls are capable of functioning as desired in the claimed invention. Accordingly, it is unpredictable that explants other than stems and hypocotyls can be used to practice the claimed invention as commensurate in scope with the claims.

Re any plant:

Applicant claims any plant. Applicant teaches soybean and potato, which are dicot plants. Dicot plants are not representative of all plants. Especially they are not representative of monocot plants. The properties of stems of dicot plants differ from those of monocot plants (Raven et al, Biology of Plants (1992), Worth Publishers, New York, NY 10003, pages 382, Table 18, and 494-5, Figures 23-8, 23-9 and 23-10). Dicots show secondary growth, characterized by the presence of secondary meristematic tissue. Dicot stem cells have the capacity to dedifferentiate and become meristematic, whereas monocot stems cells do not have this capacity. It is unpredictable that plants other than dicots would be capable of functioning in the same way as the dicots in the claimed invention. Neither the prior art nor Applicant's disclosure shows that plants other than dicots are capable of functioning as desired in the claimed invention. Accordingly, it is unpredictable that plants other than dicots can be used to practice the claimed invention as commensurate in scope with the claims.

In view of the breadth of the claims (any explant and any plant) and the lack of guidance in the specification, undue experimentation would be required to enable the invention as commensurate in scope with the claims. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Remarks

7. No Claim is allowed.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Georgia L. Helmer whose telephone number is 703-308-7023. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on 703-306-3218. The fax phone numbers for

the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Georgia L. Helmer PhD
Patent Examiner
Art Unit 1638
November 27, 2002


PHUONG T. BUI
PRIMARY EXAMINER